REMARKS

Upon entry of this amendment, claims 1-14 are all the claims pending in the application. By this Amendment, Applicant adds claims 11-14. Claims 11-14 are clearly supported throughout the specification, for example, see Figure 3 and page 5, lines 19 to 35 of the Specification.

In addition, Applicant amends claims 4, 5, 7 and 10 solely for improved conformance with the US practice. It is respectfully submitted that these conformity-related amendments have not narrowed the scope of the claims in any way, and do not constitute any impermissible new matter.

I. Preliminary Matters

Applicant thanks the Examiner for acknowledging the claim to foreign priority and for confirming that the certified copy of the priority document was received. Applicant also thanks the Examiner for initialing the references listed on form PTO-1449 submitted with the Information Disclosure Statement filed on May 23, 2001.

Finally, on Form PTOL-326, the Examiner has indicated that claims 1-9 are pending in the Application, whereas claims 1-10 were pending in the Application and by this Amendment, claims 1-14 are pending in the Application. Applicant respectfully requests the Examiner to correct this inaccuracy in the next office communication.

II. Summary of the Office Action

The Examiner rejected claims 1 and 4-6 under 35 U.S.C. § 102(e), as being anticipated by U.S. Patent No. 6,223,037 to Parkkila (hereinafter "Parkkila") and claims 9-10 under 35 U.S.C. § 102(e), as being anticipated by U.S. Patent No. 6,343,070 to Klas et al. (hereinafter "Klas"). In addition, claims 2-3 are rejected under 35 U.S.C. § 103(a), as being obvious in view of Parkkila and U.S. Patent No. 5,701,585 to Kallin et al. (hereinafter "Kallin") and claims 7-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Parkkila in view of U.S. Patent No. 6,418,318 to Bamburak et al. (hereinafter "Bamburak").

III. Claim Rejections under 35 U.S.C. § 102(e)

The Examiner rejected claims 1, 4-6 and 9-10 under 35 U.S.C. § 102(e). Applicant respectfully traverses this rejection and respectfully requests the Examiner to reconsider and withdraw this rejection in view of the comments, which follow.

Claims 1 and 4-6

Claims 1 and 4-6 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Parkkila. Of these claims, only claim 1 is independent. Claim 1, as now amended, recites:

> periodically scanning frequencies of said radiocommunication network when signal intensity was constant before said standby, using one or more sequences each associated with a predetermined list of frequencies from all said frequencies.

The Examiner asserts that claim 1 is directed to a method of connecting a terminal to a network and is anticipated by Parkkila (see page 3 of the office action). Parkkila teaches selecting cells in a selected network during loss of signal (see *Abstract*). In particular, Parkkila teaches that the

base station (BS) broadcasts its digital channels and the neighboring carrier channels on a digital broadcast control channel (BCCH) (col. 6, lines 53 to 67). A mobile station (MS) measures the signal intensity of the received six strongest carriers (col. 7, lines 14 to 34). Therefore, when the signal intensity of these channels falls below the path loss threshold (C1) for a predetermined period of time, MS will still first measure these six strongest carriers as opposed to fully scanning all frequencies (Fig. 3; col. 7, lines 48 to 63). Yet, if after a predetermined period of time, a channel is not found whose measurements is above the threshold C1, then a full search is performed (col. 8, lines 1 to 29).

However, Parkkila teaches that once a connection is lost, only partial searches are performed at first, and only after the failure of these partial searches for a predetermined period of time is the full search performed. That is, Parkkila fails to teach or suggest performing periodic scanning using one or more sequences, if the signal intensity was constant. In fact, in Parkkila, these searches of the most recently available channels will always be performed, whether the MS has left the area or entered a dead zone (e.g., an elevator).

In short, Parkkila fails to teach or suggest monitoring signal intensity to see if it is constant. The measurements that are performed in Parkkila are only to see if the signal intensity is above the path loss threshold (C1). In other words, Parkkila performs scanning of the previously received strongest carriers regardless of whether signal intensity was constant or not.

Therefore, *if signal intensity was constant before said standby, periodically scanning frequencies of said radiocommunication network using one or more sequence* as set forth in claim 1 is not suggested or taught by Parkkila, which lacks performing periodic partial

scanning based on whether the signal intensity was constant before the loss of connection. For at least these reasons, Applicant respectfully submits that independent claim 1 is patentably distinguishable from Parkkila. Applicant, therefore, respectfully requests the Examiner to reconsider and to withdraw this rejection of independent claim 1. Also, Applicant respectfully submits that claims 4-6 are allowable at least by virtue of their dependency on claim 1.

Claims 9-10

Claims 9-10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Klas. Of these claims, only claim 9 is independent. Claim 9, as now amended, recites:

> means for determining what type of scanning to perform based on signal intensity;

The Examiner asserts that claim 9 is directed to a terminal adopted to connect to a radiocommunication network and is anticipated by Klas (see pages 4-5 of the office action). Klas teaches a method of acquiring communication with a communication system having plurality of communication channels (*Abstract*). In particular, Klas teaches if CDMA communication is lost then the terminal attempts to acquire an AMPS communication. Even if, AMPS communication is acquired, the system performs partial scans (e.g. of the previously acquired CDMA channels or specified CDMA channels), *see* Figs. 6 and 7; col. 10, lines 30 to 40.

However, Klas teaches performing periodical searches to see if CDMA channel becomes available. These partial CDMA searches are interleaved with conventional AMPS scans. The processor, based on time determines which search to perform (Fig. 6; col. 9, lines 56 to col. 10,

lines 9). In addition, the processor may alternate between partial search of previously acquired CDMA channels and partial search of specified CDMA channels (Fig. 7; col. 10, lines 31 to 53). But all of these different types of searches are not being performed based on signal intensity. If communication is lost, Klas teaches that a search will be performed. However, what type of search to perform is based on the type of channel that was lost, time and other searches previously performed but not on the intensity of the signal.

Therefore, *means for determining what type of scanning to perform based on signal intensity* as set forth in claim 9 is not suggested or taught by Klas, which lacks determining type of scanning to perform based on signal intensity. For at least these reasons, Applicant respectfully submits that independent claim 9 is patentably distinguishable from Klas. Applicant, therefore, respectfully requests the Examiner to reconsider and withdraw this rejection of independent claim 9. Also, Applicant respectfully submits that claim 10 is allowable at least by virtue of their dependency on claim 9.

IV. Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 2-3 and 7-8 under 35 U.S.C. § 103(a). Applicant respectfully traverses this rejection and respectfully requests the Examiner to reconsider and withdraw this rejection in view of the comments, which follow.

Claims 2-3

Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parkkila in view of Kallin. Applicant respectfully traverses this rejection with respect to the

dependent upon claim 1, claims 2-3. Applicant has already demonstrated that Parkkila does not meet all the requirements of independent claim 1. Kallin is relied upon only for its teaching of ranking the cells according to importance. That is, Kallin teaches that the order of the list in which the search is performed can be varied based on present environment or on prior knowledge (col. 4, lines 31 to 45). However, Kallin fails to cure the deficiencies in Parkkila teachings. Kallin only teaches that since measuring signal strength and other characteristics of the cell is usually limited to a maximum number of 12, 20 or 32, it may be beneficial to pre-select these 12, 20 or 32 cells (col. 1, lines 20 to 50). The cells can be ranked by quality of service and type (col. 2, lines 8 to 16).

In short, Kallin does not compensate for the above-identified deficiencies of Parkkila. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 1. Since claims 2-3 are dependent upon claim 1, they may be patentable at least by virtue of their dependency.

Claims 7-8

Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parkkila in view of Bamburak. Applicant respectfully traverses this rejection with respect to the dependent upon claim 1, claims 7-8. Applicant has already demonstrated that Parkkila does not meet all the requirements of independent claim 1.

Bamburak is relied upon only for its teaching of determining last frequency band of the last service provider before disconnection. That is, Bamburak teaches that after power up, the mobile station checks the most recently used control channel to determine whether an optimal

service provider is available on the channel. If this optimal service provider is not obtainable, then searches through the frequency spectrum in a pre-determined order until an optimal or acceptable service provider is located (col. 3, lines 45 to 67).

In short, Bamburak does not compensate for the above-identified deficiencies of Parkkila. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 1. Since claims 7-8 are dependent upon claim 1, they may be patentable at least by virtue of their dependency.

V. New Claims

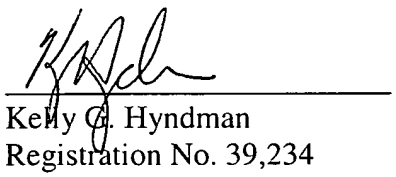
In order to provide more varied protection, claims 11-14 are added. Claims 11-13 are patentable at least by virtue of their dependency on claim 9 and claim 14 is patentable at least by virtue of its dependency on claim 1.

VI. Conclusion and request for telephone interview

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,



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